REMARKS

Claim Rejections

Claims 12-20 are rejected under 35 U.S.C. § 103() as being unpatentable over Pruett et al. (6,263,440) in view of Lam et al. (5,545,583).

Double Patenting

The Examiner's withdrawal of the double patenting rejection is noted.

Claim Amendments

By this Amendment, Applicant has canceled claims 17-18 and has amended claim 12 this application. Claim 1 has been amended to include the subject matter of claims 17 and 18. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The cited reference to Pruett et al. teaches a system for tracking and protecting display monitors by reporting their identity that includes a computer (10) having a power supply (17), a power button (21), a first chipset (44), a CPU host bus (42), and a second chipset (52). The second chipset is connected to a PCI bus (50), which is also connected to the CPU host bus and the first chipset.

As noted by the Examiner, on page 4 of the outstanding Office Action, Pruett et al. do not teach the flash memory array. Pruett et al. do not teach a flash memory array having a plurality of flash memories, the flash memory array being connected to the flash memory controller for saving data, the flash memory controller and the flash memory array being electrically connected to a circuit board; the flash memory controller and the flash memory array being enclosed in a casing; nor do Pruett et al. teach the plurality of flash memories comprises ten flash memories divided into five groups.

Additionally, Pruett et al. teaches the flash memory interface being a chip, but unlike the present invention does not teach the flash memory controller being an MX9691 controller. Absent written documentation Applicant respectfully traverses Examiners conclusion that the chip taught in Pruett et al. is equivalent to the MX9691 controller of the present invention.

The cited reference to Lam et al. recites a method of making a semiconductor trench capacitor cell having a buried strap.

Lam et al. states, at col. 2, lines 17-21:

> There exists a continuing demand for semiconductor memory device designs and processes which utilize fewer processing sequences, while at the same time facilitating greater storage capacity and allowing more densely packed memory arrays.

In the background of the invention, Lam et al. state that there is continuing demand to improve Dramatic Random Access Memory (DRAM) cells and teaches a memory array (Fig. 7). However, Lam et al. do not teach that the memory array is a flash memory array having a plurality of flash memories. Applicant respectfully traverses the cited reference as teaching a flash memory array.

Lam et al. do not teach a power source; an IDE interface; a flash memory controller; a flash memory array having a plurality of flash memories, the flash memory array being connected to the flash memory controller for saving data, the flash memory controller and the flash memory array being electrically connected to a circuit board; the flash memory controller and the flash memory array being enclosed in a casing; the flash memory controller being an MX9691 controller; nor do Lam et al. teach the plurality of flash memories comprises ten flash memories divided into five groups.

Even if the teachings of Pruett et al. and Lam et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: 1) a flash memory array having a plurality of flash memories; 2) the flash memory controller and the flash memory array being electrically connected to a circuit board; 3) the flash memory controller and the flash memory array being enclosed in a casing; 4)

the flash memory controller being an MX9691 controller; nor does the combination teach 5) the plurality of flash memories comprises ten flash memories divided into five groups.

On page 4 of the outstanding Office Action, the Examiner admits that the reference to Pruett et al. does not teach a flash memory array, and cites the secondary reference to Lam et al. as teaching it in "the abstract". Applicant submits that there is not the slightest suggestion in either Pruett et al. or Lam et al. of combining the flash memory array with the remainder of the elements as specifically set forth in Applicant's claims. It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

> The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

> As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

> We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

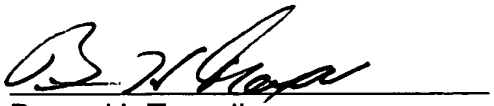
There is not the slightest suggestion in either Pruett et al. or Lam et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Pruett et al., nor Lam et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious the amended claims.

Summary

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: January 20, 2004 By: 

Bruce H. Troxell
Reg. No. 26,592

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707